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Filing date: **03/26/2013**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91208855
Party	Plaintiff Greater Louisville Convention & Visitors Bureau
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Submission	Motion to Amend Pleading/Amended Pleading
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Date	03/26/2013
Attachments	91208855-Motion to Amend Counterclaim Answer.pdf (3 pages)(125571 bytes) 91208855-Amended Counterclaim Answer.pdf (4 pages)(121714 bytes)

**Greater Louisville Convention
and Visitor's Bureau**

Opposer

v.

The Wine Group LLC

Applicant

) **IN THE UNITED STATES**
) **PATENT AND TRADEMARK OFFICE**
)
)
) **TRADEMARK TRIAL AND APPEAL BOARD**
)
)
) **APPL. NO. 85/736,374**
)
) **OPPOSITION NO. 91208855**
)

OPPOSER'S MOTION TO AMEND ANSWER

Greater Louisville Convention and Visitor's Bureau ("Louisville", "Opposer", or "Plaintiff"), by and through its below-identified attorneys, hereby moves to amend its answer to The Wine Group LLC's ("Wine Group", "Applicant", or "Defendant") counterclaim, and states as follows:

I. Louisville Has Amended Its Affirmative Defenses to be Sufficient for Fair Notice.

As further discussed in Louisville's opposition to Wine Group's motion to strike, filed contemporaneously with this motion to amend, Louisville's affirmative defenses are sufficient to give Wine Group fair notice of the bases for the defenses. Louisville's amended answer is included with this motion.

II. Leave to Amend a Pleading Should be Freely Given.

The Federal Rules of Civil Procedure provide that a pleading may be amended by leave of court, and that "such leave shall be freely given". Fed. R. Civ. P. 15(a), TBMP 507.01(2). Leave should be particularly given in the absence of any showing of prejudice. *Foman v. Davis*,

371 U.S. 178, 182 (1962); *Smith v. Angelone*, 111 F.3d 1126, 1134 (4th Cir. 1997); *Davis v. Piper Aircraft Corp.*, 615 F.2d 606, 613 (4th Cir. 1980).

Here, Wine Group will not be prejudiced, because this proceeding is at a very early stage and Wine Group has not relied on the affirmative defenses as they were stated in Louisville's initial answer to the counterclaim. Moreover, as Louisville's initial answer did not require a responsive pleading and no such responsive pleading was filed (TBMP 311.03), Louisville's amended answer will not necessitate the re-filing of any responsive pleading.

Respectfully submitted,

/John A. Galbreath/

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Attorneys for Opposer

Certificate of Service: I certify that on the date below, the foregoing Motion to Amend Answer and referenced attachments, if any, were sent by first-class mail to:

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241 EAGLE TRACE DRIVE, SECOND FLOOR
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26 March 2013

/John A. Galbreath/
John A. Galbreath

**Greater Louisville Convention
and Visitor's Bureau**

Plaintiff/Opposer

v.

The Wine Group LLC

Defendant/Applicant

) **IN THE UNITED STATES**
) **PATENT AND TRADEMARK OFFICE**
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)
) **TRADEMARK TRIAL AND APPEAL BOARD**
)
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) **APPL. NO. 85/736,374**
)
) **OPPOSITION NO. 91208855**
)

OPPOSER'S AMENDED ANSWER TO COUNTERCLAIM

Greater Louisville Convention and Visitor's Bureau ("Louisville", "Opposer", or "Plaintiff"), by and through its below-identified attorneys, hereby amends its answer to The Wine Group LLC's ("Wine Group", "Applicant", or "Defendant") counterclaim, and states as follows:

1. Regarding paragraph 1 of the counterclaim, Opposer admits that Applicant is listed by the USPTO as the owner of application no. 85/736,374. Opposer is otherwise without sufficient knowledge or information to form a belief as to the allegations of paragraph 1, and denies the same leaving Applicant to its proof.
2. Opposer admits the allegations of paragraph 2 of the counterclaim.
3. Opposer denies the allegations of paragraph 3 of the counterclaim.
4. Opposer denies the allegations of paragraph 4 of the counterclaim.
5. Opposer denies the allegations of paragraph 5 of the counterclaim.

AFFIRMATIVE DEFENSES

First Affirmative Defense

The counterclaim fails to state a claim upon which relief can be granted.

Second Affirmative Defense – Estoppel by Laches

1. Wine Group's cancellation counterclaim is estopped by laches.
2. Wine Group knew that Louisville was already using its URBAN BOURBON and URBAN BOURBON TRAIL marks in commerce, since at least as early as Wine Group's application for the (B)URBAN mark on September 24, 2012.
3. Wine Group knew that Louisville had already registered its URBAN BOURBON TRAIL mark on March 15, 2011, since at least as early as Wine Group's application for the (B)URBAN mark on September 24, 2012.
4. Wine Group knew that Louisville had already registered its URBAN BOURBON mark on July 24, 2012, since at least as early as Wine Group's application for the (B)URBAN mark on September 24, 2012.
5. Wine Group knew that Louisville had already applied for registration of its URBAN BOURBON EXPERIENCE mark on August 24, 2011, and that this application had been allowed, since at least as early as Wine Group's application for the (B)URBAN mark on September 24, 2012.
6. Wine Group now seeks to cancel Louisville's URBAN BOURBON mark, despite having known of its use and registration since at least as early as Wine Group's application for the (B)URBAN mark on September 24, 2012.
7. Louisville has been prejudiced as a result.

Third Affirmative Defense – Unclean Hands

1. Wine Group has acted in bad faith, and its cancellation counterclaim is barred by the doctrine of unclean hands.

2. Wine Group filed the (B)URBAN application with knowledge that Louisville was already using its URBAN BOURBON and URBAN BOURBON TRAIL marks in commerce, had already registered those marks, and had also applied to register its URBAN BOURBON EXPERIENCE mark.

3. Wine Group sought to benefit from Louisville's advertising and promotion of its URBAN BOURBON, URBAN BOURBON TRAIL, and URBAN BOURBON EXPERIENCE marks, in order to increase the appeal of the (B)URBAN mark for bourbon liquor.

4. Wine Group has no knowledge that Louisville has never used its URBAN BOURBON mark for the specified services; no knowledge that Louisville's URBAN BOURBON mark was not in use at the time it filed the specimen of use; and no knowledge that Louisville's URBAN BOURBON mark was not in use at the time of registration.

5. Wine Group has no knowledge that Louisville did not have a *bone fide* intention to use its URBAN BOURBON mark as of the filing date.

6. Wine Group has no knowledge that Louisville did not exercise quality control over the services in connection with licensing its URBAN BOURBON mark.

7. Wine Group made its counterclaim solely in an attempt to pressure Louisville into dropping its justified opposition to the (B)URBAN application.

8. Wine Group has since explicitly engaged in such pressure.

Respectfully submitted,

/John A. Galbreath/

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